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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/177,047	10/22/1998	KENNETH L. BRINKLEY		2616
7590 FROST & JACOBS 2500 PNC CENTER 201 EAST FIFTH STREET CINCINNATI, OH 45202				
07/17/2009				
EXAMINER				
JOHNSON, STEPHEN				
ART UNIT		PAPER NUMBER		
3641				
MAIL DATE		DELIVERY MODE		
07/17/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/177,047

Applicant(s)

BRINKLEY, KENNETH L.

Examiner

Stephen M. Johnson

Art Unit

3641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22, 26, 63 and 66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22, 26, 63 and 66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. This Office action is in response to the amendment as filed on 4/21/2009. An action on pending claims 22, 26, 63 and 66 follows. Claims 1-21, 23-25, 27-62, 64-65, and 67 have been cancelled.
2. Claims 22, 26, 63, and 66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. In claims 22 and 63, it is not understood as to how applicant's electrical circuit can generate a second signal indicative of the number of firearm discharges when applicant's inertia sensor is configured to generate at least one first signal in response only to **substantially each discharge** of the firearm. Please clarify.
4. Claims 22, 26, 63, and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by Busch (299).

Busch (299) discloses a firearm monitoring device comprising:

- | | |
|---|-----------------------------|
| a) an inertia sensor; | 30, 40; col. 2, lines 23-29 |
| b) generates a first signal in response to target contact or firearm discharge; | 80, 85, 95 |
| c) generating a second signal indicative of the number of firearm discharges; | 150, 184, 60 |
| d) ignores any signals generated within a time period after the first signal; and | col. 4, lines 28-58 |
| e) in combination with a firearm. | col. 1, lines 4-8 |

5. Applicant's arguments are addressed as follows. It is argued that Busch discloses a hit scoring apparatus. This is accurate. However, Busch also discloses a firearm monitoring device albeit an indirect monitoring device. Note that one cannot have a hit on a target where only a gun is firing at the target if the firearm is not being fired. With regard to the argument that the claim language directed to "configured to generate at least one first signal in response to substantially each discharge", note that the term substantially each discharge could include any shooter that is accurate enough to hit the target substantially each time. Consequently, the claims as drawn do not even require that every discharge of the firearm be monitored and/or that every bullet hit the target. It is argued that Busch is only indicative of the number of impacts or hits on the target. In response, Busch is also indicative of the number of discharges of the firearm if the shooter hits the target each time he fires. This is possible at either short ranges or with firing only a few times by an accurate shooter. With regard to the issue of the claim limitations directed to "ignores any signals generated within a time period after the first signal"; note col. 4, lines 28-58 of Busch.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 22, 26, 63, and 66 are rejected under 35 U.S.C. 112, first paragraph, as **failing to comply with the written description requirement**. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 22 and 63, the claim language directed to "to ignore any signals generated by said inertia sensor within a predetermined time period **following the generation of**

an initial one of a series of said first signals” is unsupported by the application as originally filed.

8. Claims 22, 26, 63, and 66 are rejected under 35 U.S.C. 112, first paragraph, as **failing to comply with the enablement requirement**. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claims 22 and 63, the claim language directed to “to ignore any signals generated by said inertia sensor within a predetermined time period **following the generation of an initial one of a series of said first signals”** is unsupported by the application as originally filed.

9. Claims 22, 26, 63, and 66 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Subject matter has been entirely eliminated from the claims of the reissue application that was added to overcome an art rejection (see applicant's response as filed on 2/20/1996 in serial number 08/376,047). Note the claim language directed to "for attaching to a firearm, said firearm having a firing end and a grip end" and "wherein said first means comprise an inertia switch comprising a moveable mass; and wherein said mass is resiliently biased toward the firing end of the firearm".

10. Applicant's arguments filed on 4/21/2009 with regard to Busch have been fully considered but they are not persuasive. These arguments have been addressed in paragraph 3 above.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. Johnson whose telephone number is 571-272-6877 and whose e-mail address is (Stephen.Johnson@uspto.gov). The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571-272-6873. The Central FAX phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 800-786-9199.

/Stephen M. Johnson/
Primary Examiner, Art Unit 3641

SMJ
July 16, 2009